

Serial No. 09/714,756

Lorin Evan Ullmann

Page 11 of 16

**Section IV:**  
**AMENDMENT UNDER 37 CFR §1.121**  
**REMARKS**

**Telephone Interview Request**

Applicant's agent, Robert H. Frantz, requests a telephone interview with the examiner following examiner's consideration of this reply and amendment in order to facilitate clarification of any of the remarks or amendments made herein, should the examiner have any questions, and to consider any suggestions from the examiner in order to place this case in condition for allowance. Applicant's agent requests the examiner to contact him at 405-812-5613 to indicate a date and time when the examiner would be available to receive a telephone call.

**Rejections under 35 U.S.C. §102(e)**

In the Office Action, the examiner has rejected claims 1 - 27 under 35 U.S.C. §102(e) for lack of novelty as being anticipated by U.S. Patent Number 6,185,551 to Birrell, *et al.* (hereinafter "Birrell"). Claims 1, 10, and 19 are independent claims, and all other claims are dependent claims.

With respect to the rejections of Claims 1, 10, and 19:

- (a) Birrell's "parsing" is on a word basis in which each word is provided an location index, which is not the same as our parsing of a message into discussion entries in chained message as we have defined "discussion entries":

**Chained messages** are forwarded several times or replied to several times. The method used employed by common SMTP e-mail software programs to display the multiple replies and comments can be somewhat confusing. For example, Table 4 shows one method that common e-mail software uses to display the forwarded text

Serial No. 09/714,756

Lorin Evan Ullmann

Page 12 of 16

components of a chain-forwarded electronic message. In this example a right arrow or greater than symbol ">" is used to indicate how many previous instances of forwarding or replying levels have occurred for a given portion of the message. (pg. 13 lines 7 - 13, emphasis added)

...

As can be seen from the example given in Table 4, each time a portion of a text message is forwarded to a new recipient, an additional forwarding character is added along the left margin of the text. (pg. 14 lines 11 - 13)

...

First, the chain-forwarded text is parsed (50) into **discussion entries**. This may be done by finding common delimiters within the text of the chain-forwarded message, such as the number of special marking characters (e.g. ">", ">>", ">>>", etc.) from the left margin, or such a special HTML indicators, including horizontal bars and lines. (pg. 23 line 21 to pg. 24 line 3, emphasis added)

- (b) Birrell discloses at col. 11, lines 30 - 33, an ordinary process of sorting multiple related messages in a discussion thread, which is well known in the art to be a series of individual messages having an relationship identifier of some sort (e.g. the same subject line):

**thread 1.** In on-line discussions, a series of messages that have been posted as replies to one another. ... (Pg. 558, "Random House Webster's Computer and Internet Dictionary", Third Edition,

Serial No. 09/714,756

Lorin Evan Ullmann

Page 13 of 16

Philip E. Margolis, 1999, emphasis added)

**thread (Internet)** A series of messages relating to a specific topic or positing on a newsgroup or mailing list. (Pg. 492, "Internet and Technology Law Desk Reference" by Michael D. Scott, published by Aspen Law & Business, 1999, emphasis added)

This is not the same as our parsing of a "chained message" is a process of parsing a single message which has been forwarded and/or replied to many times and which contains repeated or quoted text from the previous replies and forward messages, as we have defined a "chained message" (please refer to the foregoing quotes from our disclosure).

- (c) Birrell's parsing process generates "metawords" and looks for standard field identifiers such as the "TO" and "FROM" metatags, which is not the same as our parsing process which looks for delimiters and message segment indicators which usually appear all within the "body" of the message that visually indicate quoted or forwarded content such as ">" characters in the left margin or HTML markings to produce a vertical bar in a margin along side quoted content, as we have defined these message segment indicators and delimiters (please refer the foregoing quotes from our disclosure).
- (d) Birrell's "sorting" of messages is a process of sorting messages relative to other messages (e.g. according to their time of receipt and their "MessageID"), which is not the same as our sorting of our discussion entries wherein the discussion entries were all found within a single "chained message" and were not originally individual messages (please refer to our foregoing quotes regarding our definitions of "discussion entry" and "chained message").

Serial No. 09/714,756

Lorin Evan Ullmann

Page 14 of 16

- (e) Birrell's "reduction" of messages refers to the maintenance of their specific "labels" which are associated with entire messages, which is not the same as our reformatting of our discussion entries to reduce redundant information such as text which is repeated more than once, etc., within a chained-message.
- (f) Birrell's "outputting" function as cited by the examiner simply refers to the process of displaying or printing a message and changing its status label from "unread" to "read", which is not the same as our process outputting a "thread-of-discussion" format message as we have defined it, which includes reformatting the discussion entries such as removal of unnecessary fields, delimiters, time stamps, etc.:

During the reformatting (44) stage, all unnecessary fields for interpreting the thread of discussion are eliminated from the displayed text, such as the FROM, REPLY\_TO and SUBJECT fields, and optionally any time stamps. In some embodiments the time stamps may be retained, but in most embodiments the time stamps will be removed. Also, any special texts or markings in the original forwarded text, such as the greater than symbols ">" may be removed in order to provide greater readability.

Preferably, the system also searches an address book for nicknames or first names of recipients and originators. In order to enhance readability of the discussion thread, these nicknames and preferred names are used as simple and short labels for the entries in the discussion thread, rather than using or showing the full e-mail

Serial No. 09/714,756

Lorin Evan Ullmann

Page 15 of 16

addresses. (pg. 23 lines 5 - 16)

As such, the rejections should be withdrawn and Claims 1, 10 and 19 allowed for the following reasons:

1. The cited reference does not properly anticipate the claimed invention, as it fails to disclose all the claimed steps, elements or limitations as previously discussed. MPEP 2131 states:

TO ANTICIPATE A CLAIM, THE REFERENCE MUST TEACH EVERY ELEMENT  
OF THE CLAIM (*capitalization emphasis found in original text*)

Birrell fails to teach parsing a chained message into discussion entries, sorting those discussion entries into a preferred order, reducing those entries and reformatting them into a thread-of-discussion format.

2. The cited reference does not properly anticipate the claimed invention, as it fails to disclose all the claimed steps, elements or limitations as set forth according to the applicant's terminology. Terminology and definitions of the cited reference(s) have been improperly employed to interpret the meaning and scope of the applicant's claims. MPEP 2173.01 states:

**MPEP 2173.01 Claim Terminology.** A fundamental principle contained in 35 U.S.C. 112, second paragraph is that applicants are their own lexicographers. They can define in the claims what they regard as their invention essentially in whatever terms they choose so long as the terms are not used in ways that are contrary to accepted meanings in the art.

Further, MPEP 608.01 states:

The claims should be construed in light of the specification.

Birrell does not provide definitions of, nor does Birrell employ the terms "discussion entry" or "chained message".

Serial No. 09/714,756

Lorin Evan Ullmann

Page 16 of 16

With respect to the rejections of claims 2 - 9, 11 - 18, and 20 - 27, the rejections should be withdrawn and the claims allowed because each of these claims recites elements, steps or limitations provided by the claims from which they depend which are not taught by the Birrell disclosure, as discussed in the foregoing remarks.

**Conclusion**

The claims have been amended to render them even more clearly distinct from the cited art, and the definitions for the terms of the claims as originally filed in our disclosure have been specifically compared to the disclosure of the cited art to illustrate the differences between the cited art and our claimed invention. Applicant requests reconsideration and withdrawal of the rejections, and allowance of the claims.

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